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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,690	12/04/2001	Richard Wojdyla	5384/55373 9872	
	7590 01/23/2007	EXAMINER		
KEITH E. GEORGE, ESQ. McDERMOTT, WILL & EMERY 600 13th STREET N.W. WASHINGTON, DC 20005-3096			LE, UYEN CHAU N	
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WASHINGTO	14, 150 20005-5090		2876	
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SHORTENED STATUTOR	Y PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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		Application No.	Applicant(s)			
Office Action Summary		10/007,690	WOJDYLA ET AL.			
		Examiner	Art Unit			
		Uyen-Chau N. Le	2876			
Period fo	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1)⊠	Responsive to communication(s) filed on 26 Oc	ctober 2006.				
	This action is FINAL . 2b) ☐ This action is non-final.					
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
,	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4)⊠	4)⊠ Claim(s) <u>1-4,8-18 and 21-32</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.						
	5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1-4,8-18 and 21-32</u> is/are rejected.						
	Claim(s) is/are objected to.					
· <u> </u>	Claim(s) are subject to restriction and/or	r election requirement.				
	on Papers	•				
	·					
	The specification is objected to by the Examine					
10)	The drawing(s) filed on is/are: a) acce					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11)	The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.			
Priority u	ınder 35 U.S.C. § 119					
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
Attachment(s)						
1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s)/Mail Date						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 10/26/2006. Paper No(s)/Mail Date 5) Notice of Informal Patent Application 6) Other:						

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 10/26/2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1-2, 4, 9-10, 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cordery et al (US 6,073,125).

Re claims 1-2, 4, 9-10, 12-14 and 16: Cordery et al discloses a method for providing trace-ability of mail pieces, comprising the steps of: creating a plurality of mail pieces 104; providing a first tracing code (i.e., encrypted indicia 108) on each of the plurality of mail pieces 104 (col. 3, lines 30-32 and lines 53-56); creating a mailing statement 106 for the plurality of mail pieces 104 (fig. 1; col. 3, lines 50+); providing a second tracing code 312 on the mailing statement 106

(fig. 3; col. 3, lines 32+ and col. 5, lines 7-45); and submitting the plurality of mail pieces to a postal service facility (col. 4, lines 52+); wherein the first tracing code is encrypted (col. 3, lines 28+); wherein the first tracing code is independent from a meter imprint (i.e., the first tracing code is encrypted by utilizing a random digital token key K_m); various mail pieces are delivered to a carrier acceptance unit 116 along with statements of the mailing, which can be in hard copy form or electronic form, where the first tracing code 108 on each of the mail pieces and the second tracing code on the statements of mailing are verified via an acceptance unit scanner (col. 4, lines 1-31); verifying that the encrypted source tracing code corresponds to a source tracing code (fig. 5; col.6, lines 34-The first tracing code 108 related to various information including origin postal code, which can be traced even in the event the mailer deposited mail in different locations or used various carrier services in sending mail to various recipients (fig. 2; col. 4, lines 42-58), thus the first tracing code 108 corresponding to a source of the mail pieces and can be traced back to the original location/source via the origin postal code upon reading the first tracing code 108. The second tracing code 312 is the encryption by utilizing the digital key K_m with the public key of the acceptance unit P_{AU} , which used to verify

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the first tracing code/indicia 108 printed on the mail-piece (fig. 3; col. 5, lines 20-31), therefore the second tracing code 312 corresponding to the source of the mail pieces; wherein the step of providing a first tracing code on each of said plurality of mail pieces includes the step of passing each of said through tracing code producing plurality of mail pieces equipment, independent of a meter (fig. 2; col. 4, line 37 through col. 5, line 6).

Claim Rejections - 35 USC § 103

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the Applicant is advised of the obligation under 37 CFR 1.56 to

point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Clark et al (US 4829568 A). The teachings of Cordery et al have been discussed above.

Re claim 3: Cordery et al has been discussed above, but is silent with respect to the first tracing code corresponds to the characteristics of the mail pieces.

Clark et al teaches a package having a postage indicia imprint supported thereon relating to a characteristic of the package (claim 11).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the tracing code of Cordery et al to further include at least a characteristic of the mail piece as taught by Clark et al in other to provide Cordery et al with a more accurate system wherein the correct mail piece can be confirmed instantaneously upon reading the first tracing code (i.e., based on the included characteristic of the mail piece).

7. Claims 8, 15, 18, 21-25, 27-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Simon (US 20030085266 A1). The teachings of Cordery et al have been discussed above.

Re claims 8, 15, 18, 21-25, 27-28 and 30-31: Cordery et al has been discussed above, but is silent with respect to capturing and recording an identity of an individual submitting at least one mail piece.

Simon teaches a mail-collection receptacle equipped with a receiver 3, which performs the two-fold function of capturing a digital photographic image of an individual piece of mail 2 being deposit into the mail-collection receptacle 1 and the face of a person making the deposit (figs. 1 & 2; paragraph [0032]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a camera of Simon into the system as taught by Cordery et al in order to provide Cordery et al with a more secure system in the actual mailer/sender of suspicious/harmful mails can be identified/traced instantly upon detection of the suspicious/harmful mails via the record of the mails submitter's identity (i.e., his photograph).

8. Claims 11, 17, 26, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by

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Simon as applied to claim 1 above, and further in view of Pintsov (US 6,009,416). The teachings of Cordery et al as modified by Simon have been discussed above.

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Re claims 11, 17, 26, 29 and 32: Cordery et al/Simon have been discussed above but is silent with respect to providing an alert indication when the first tracing code does not correspond to the second tracing code.

Pintsov teaches a suitable investigation can be implemented when information obtained from a scanned mail piece does not match with the correspond statement of mailing (col. 11, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further perform an investigation process when the first tracing code does not match the second tracing code as taught by Pintsov to provide Cordery et al/Simon with a more secure system wherein any suspicious mails can be notified, stopped and/or investigated immediately, preventing any harmful (e.g., anthrax, etc.) mails from being further processing in the event of terror.

Response to Arguments

9. Applicant's arguments filed 10/26/2006 have been fully considered but they are not persuasive.

- In response to the Applicant's argument with respect to "... Corderv et al. relates to mail payment systems, and is concerned with verifying payment and preventing counterfeit postage... is not concerned with source identification of mail pieces for mail security and traceability..." (p. 10, 3^{rd} paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al wherein although Cordery et al is not specifically addressed the concern with source identification of the mail pieces, the source identification with the mail pieces can be identified readily through the system process (i.e., via the origin post code, which related to the encrypted indicia Km, the original location, which serves as the source, of the mail pieces can be identified instantaneously (see col. 4, lines 42-58)). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).
- 11. In response to the Applicant's argument with respect to "… The digital token key Km used in Corderv et al. is not a source tracing code corresponding to a source of the mail piece, used for source tracing purposes…" (p. 10, 4^{th} paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein K_m is a digital key used to generate the encrypted indicia, which is relating to

an origin post code, which serves as the source (i.e., an original location/source of the mail piece can be identified instantaneously via the origin post code (see col. 4, lines 42-58)). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

- In response to the Applicant's argument with respect to "... Corderv et al. does not disclose use of either of the meter keys P_{MID} and P'_{MXD} on the mail pieces or to verify source or trace the mail pieces to a source..." (p. 12, 1st paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein P_{MID} and P'_{MXD} are digital keys used in the decryption process to decrypt the encrypted indicia, which is relating to an origin post code, which serves as the source (i.e., an original location/source of the mail piece can be identified instantaneously via the origin post code (see col. 4, lines 42-58)). Accordingly, the limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).
- 13. In response to the Applicant's argument with respect to "...

 Cordery et al.'s encrypted indicia do not anticipate a first

 source tracing code corresponding to the source of the mail

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pieces..." (p. 12, 3rd paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein the encrypted indicia is relating to an origin post code, which serves as the source (i.e., an original location/source of the mail piece can be identified instantaneously via the origin post code (see col. 4, lines 42-58)). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

14. In response to the Applicant's argument with respect to "... Corderv et al.'s encrypted random digital token key K_m on the statement of mail, i.e., $(K_m)P_{AU}$... does not anticipate a second source tracing code corresponding to the source of the mail pieces..." (p. 12, 4th paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein $(K_m)P_{AU}$ are the digital keys of the encrypted indicia, the encrypted indicia is relating to a second tracing code, which related to statement of mailing data, statement of mailing identification, and an origin post code (see col. 4, lines 42-58). Through $(K_m) P_{AU}$, the encrypted indicia decrypted, and via the origin post code, an original location/source of the mail piece be identified can instantaneously. Accordingly, the claimed limitation, given the

broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

- 15. In response to the Applicant's argument with respect to "… the random key Km does not correspond to anything…" (p. 12, 4^{th} paragraph), the Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein (K_m) corresponds to the encrypted indicia, which related to an origin post code (see col. 4, lines 42-58); via the origin post code, an original location/source of the mail piece can be identified instantaneously. Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).
- 16. In response to the Applicant's argument on p. 13, 3rd paragraph

Once again, the random digital token key Km does not correspond to anything - it is random. The rejection, p. 3, asserts that the key Km relates to various information including origin postal code... (citing Fig. 2 and Column 4, lines 42-58). This assertion is inaccurate. As discussed in Column 4, lines 42-58, it is the non-volatile memory 210 which stores this various information. This various information stored in the non-volatile memory 210 is used to generate or is "related to generating" the encrypted indicia and digital token (i.e., the specific meter marking or amount of digital postage, encrypted with the random digital token). However, it remains clear that the encrypted indicia with random digital token Km does not correspond to a source of the mail pieces, such that the mail pieces can be traced back to the source by reading the random digital token. Nonetheless, the origin postal code (i.e., zip code) does not correspond to the source, only at most to a general location (e.g., city).

The Examiner respect fully requests the Applicant to further review Cordery et al and the above rejection, wherein the digital key (K_m) utilized to encrypt information stored in memory

210 including origin post code, etc., thus forming/creating the encrypted indicia (see col. 4, lines 42-58); via the origin post code, an original location/source of the mail piece can be identified instantaneously. Since there is no specific definition of the source recited in the claimed invention, a source can be understood as mail box, a post office, or a city, etc. Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

17. In response to the Applicant's argument with respect to "...

Cordery et al.'s vault 114 merely generates the random digital token key Kin, it does not produce the encrypted indicia on the mail pieces. Instead, the meter imprints the encrypted indicia on the mail pieces in Corderv et al. Thus, the mail pieces in Corderv et al. are not passed through tracing code producing equipment..." (p. 15, 1st paragraph), the Examiner respect fully disagrees and requests the Applicant to further review fig. 2 of Cordery et al and the above rejection, wherein encryption engine 208 produce the encrypted indicia on the mail piece (col. 4, line 37 through col. 5, line 6). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

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18. In response to the Applicant's argument with respect to "...

Key Km is random. It is not encrypted on the mail piece. Key Km is encrypted on the statement of mailing with acceptance unit key PAU, but that is not the first tracing code which is on the mail pieces..." (p. 15, 2nd paragraph), the Examiner respect fully requests the Applicant to further review the above rejection, wherein Km is a digital token key used to encrypt information 108, which is printed on the mail piece as a first tracing code (col. 3, lines 50-61). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al meets the claimed invention (see the rejection above).

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Cordery et al discloses a mail processing system comprises an encrypted indicia on each of the mail pieces, wherein the encrypted

indicia is independent from metering imprint (col. 3, lines 53-61). Cordery et al is silent with respect to the encrypted indicia includes information relating to a characteristic of the mail piece. The secondary reference to Clark et al teaches a mail processing system comprises a postage indicia including information of a characteristic of a package which the postage indicia disposed thereon (claim 11). It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the encrypted indicia of Cordery et al to further include at least one characteristic of the mail piece/package that the encrypted indicia imprinted thereon to enhance the confirming/verifying accuracy of each mail piece/package in a mail processing system. Accordingly, the claimed limitation. given the broadest reasonable interpretation, Cordery et al in view of Clark et al meets the claimed invention (see the rejection above).

20. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Cordery et al discloses a mail processing system comprises appends the encrypted key to the mailing data and includes this in the statement of mailing data, which is signed by the mailer (i.e., capturing/recording the mailer's signature) (col. 3, lines 30-38). Cordery et al is silent with respect to capturing and recording an identity of an individual submitting the mail secondary reference to Simon teaches a processing system comprises capturing both the mail piece and the individual submitting the mail piece (paragraph [0032]). would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a step capturing and recording identity an individual of an of submitting the mail piece in addition to the step capturing/recording the mailer's signature to further enhance the security in a mail processing system (i.e., providing a safer working environment for postal employees during processing the mails by eliminating unidentified mailers from submitting explosive/terror mails). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al in

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view of Simon meets the claimed invention (see the rejection above).

- 21. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., how the step of capturing and recording the mailer/individual submitting the mail piece being performed (p. 17, 3rd paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- In response to applicant's argument that there is suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Cordery et al discloses a mail processing system comprises the steps of verify the encrypted indicia 108 of the mail piece with the

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corresponding mailing statement via encrypted indicia 312 to retrieve the mailer ID (i.e., the mailer's information can be retrieved instantaneously via the mailer ID, thus mailer/source can be identified readily) (col. 6, lines 34-55). Cordery et al is silent with respect to generating an alert indication and/or determine the reason why when the encrypted code on the mail piece does not correspond to the encrypted indicia on the mailing statement. The secondary reference to Pintsov teaches a mail processing system comprises a step of investigation when information obtained from a scanned mail piece does not match with the correspond statement of mailing (col. 11, lines 24+). It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a step of providing an alert indication and determine the reason why the scanned information does not match with the correspond mailing statement of Pintsov in addition to the verification step of Cordery et al to unidentified mail from further processing. Accordingly, the broadest claimed limitation, given the reasonable interpretation, Cordery et al in view of Pintsov meets the claimed invention (see the rejection above).

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For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

Conclusion

23. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on M-F 5:30AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Uyen-Chau N. Le Primary Examiner Art Unit 2876

Uehaule

January 10, 2007